

1639

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Jose V. TORRES

Appln. No.: 10/072,084

Examiner: Byrd, Devon R.

Filed: February 8, 2002

Group Art Unit: 1639

For: IMMUNOGENIC FORMULATION AND PROCESS FOR
PREPARATION THEREOF

Attorney Docket No.: 3648.032

RESPONSE TO RESTRICTION REQUIREMENT/ ELECTION OF SPECIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This election is responsive to the Office Action dated December 15, 2003, making a response due on or before January 15, 2004, wherein the Examiner requires Applicant to elect for prosecution from either:

Group I - Claims 1-16, drawn to the process for preparation of an immunogenic peptide mixture, classified in class 530, subclass 333.

Group II - Claims 17-19., drawn to a peptide mixture immunogenic to a pathogen, classified in class 514, subclass 2.

- Group III - Claim 20, drawn to a lipid-conjugated peptide composition, classified in class 424, subclass 283.1.
- Group IV - Claim 21, drawn to a carrier protein-conjugated peptide composition, classified in class 424, subclass 192.1.
- Group V- Claims 22-25, drawn to a method vaccination against a pathogen, classified in class 424, subclass 185.1
- Group VI- Claim 26, drawn to a method of diagnosing infection of a subject by a pathogen, classified in class 436, subclass 536.
- Group VII- Claim 27, drawn to a diagnostic kit for determining infection of a subject by a pathogen, classified in class 435, subclass 7.1.
- Group VIII- Claim 28, drawn to a process for isolating an antibody immunogenic to a pathogen, classified in class 424, subclass 280.1
- Group IX- Claims 29 and 30, drawn to a process for

isolating a gene or gene fragment,
classified in class 435, subclass 6.

Group X- Claim 31, drawn to an immunotherapy against
a pathogen, classified in class 514,
subclass 2.

The position of the Examiner can be found on pages 2-4 of
the Office Action.

In response, Applicant elects Group I, claims 1-16 with
traverse.

Traversal is for the following reasons:

Applicant believes that claims 1 to 31 relate to the same
inventive concept, regardless of the differences in the claim
preambles. Specifically, claims 1 to 16 relate to a process for
forming a peptide mixture. The peptide mixture itself, although
claimed in an independent format, is the subject of claims 17 to
19, and compositions containing this mixture is recited in
dependent claims 20 to 23. Additionally, dependent claims 24
and 25 relate back to the peptide mixture. Clearly, these
claims have a common inventive theme, and that is the origins
from which the peptide mixture arises (as recited in claims 1 to
16). Claims 26 and 27 also depend from claim 1, even though
other components of a kit are recited. Process claims 28 to 30

U.S. Application No.: 10/072,084

RESPONSE TO RESTRICTION REQUIREMENT/ELECTION OF SPECIES

Attorney Docket: 3648.032

also recite the peptide mixture of claim 17, and would thus clearly be considered within the bounds of the common inventive concept. Claim 31 relates back to claim 30, and thus contains all the limitations of that claim. Although the Applicant elects Group 1 claims, it is nevertheless believed that all claims 1 to 31 relate to a common inventive concept.

Under the Manual of Patent Examining Procedure (MPEP)
Section 803 - Restriction - When Proper:

Under the statute, an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents, and they are either independent (MPEP §806.04 - §806.04(j)) or distinct (MPEP §806.05 - §806.05(i)).

Accordingly, it is respectfully submitted that all claims are based on a common concept, that they are so closely related that a search would not be unduly burdensome, that they should be examined in the same application as part of the same invention.

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Accordingly, the indulgence of the Examiner to examine the claims of Groups I through X in this application is respectfully requested.

Election of Species

According to the Examiner, the application contains claims recite generic categories that read on a plurality of distinct species. The generic categories are as follows:

- A) A pathogen (Group I, II and V-X)
- B) A pathogenic disease (Group V)
- C) A bioinformatics methodology (Group I)
- D) A lipid moiety (Group III)
- E) A carrier protein moiety (Group IV)

The position of the Examiner can be found on pages 5 and 6 of the Office Action.

In response, Applicant elects category A, a pathogen, with traverse.

Traversal is for the following reasons:

With regard to the requirement to election of a specific "species" representative for the Group I claims, the Applicant understands that this election is made only for the purposes of facilitating prior art searching. The Applicant elects the above species with the disclaimer that the Group I claims should not be considered limited to these species in any way.

The generic category of "pathogen" may be searched under the "species" of an RNA-based virus, such as HIV, HCV or influenza. If it is necessary to narrow the search even further to one pathogen as the "species", HIV could be used. Additionally, HPV (a DNA virus) may be considered as an additional possible pathogen "species" to search. The Applicant wishes to point out that the invention defined by the Group I claims should not be considered as limited to any specific pathogen, as the method is clearly applicable to any number of different pathogens.

The generic category of "bioinformatics methodology", a term first appearing in claim 14, can be searched by using the "species" of either or both: (a) pattern matching from a sequence database, as supported in the specification for example at paragraph [0118]; and (b) sequence alignment, as supported in the specification for example at paragraph [0128]. The Applicant wishes to point out that the invention defined by claim 14 should not be considered as limited to any specific bioinformatics methodology, as a person skilled in the art would



U.S. Application No.: 10/072,084

RESPONSE TO RESTRICTION REQUIREMENT/ELECTION OF SPECIES

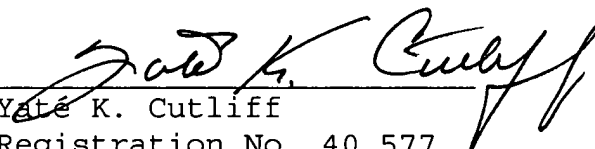
Attorney Docket: 3648.032

be able to employ any number of available methodologies to accomplish the same end goal.

Applicant appreciates that the Examiner will examine the elected species, and if allowable, will examine the remaining specie if covered in a generic claim.

Respectfully submitted,

PENDORF & CUTLIFF
5111 Memorial Highway
Tampa, Florida 33634-7356
(813) 886-6085

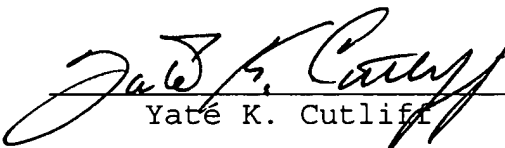

Yate K. Cutliff
Registration No. 40,577

Date: **January 14, 2004**

CERTIFICATION OF MAILING AND AUTHORIZATION TO CHARGE

I hereby certify that a copy of the foregoing RESPONSE TO RESTRICTION REQUIREMENT/ELECTION OF SPECIES for U.S. Application No. 10/072,084 filed February 8, 2002, was deposited in first class U.S. mail, postage prepaid, addressed: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **January 14, 2004**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.


Yate K. Cutliff